



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,324	09/16/2003	Tetsuya Kanekon	030192A	9165
38834 7590 09/17/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
LOFTUS, ANNE				
ART UNIT		PAPER NUMBER		
3692				
NOTIFICATION DATE		DELIVERY MODE		
09/17/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/662,324

Applicant(s)

KANEKON, TETSUYA

Examiner

ANN LOFTUS

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11, 14, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-11, 14, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to an amendment filed on 6/16/09. Claims 1-3, 6-11, 14, 15, and 17 are pending. Claims 4, 5, 12, 13, and 16 are cancelled.

Priority

2. This application was filed 9/16/03. Its oath claims foreign priority from Japanese Patent 2002-275073 dated 9/20/02. A certified copy and a translation are now present in the record.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission has been entered.

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The applicant argues that Wilson does not teach transmitting a

lock release request for releasing a lock of the system. Wilson has been replaced by Lejeune.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The written description (including the drawings and original claims and incorporated references) is required to support possession of the claimed scope of the invention. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. If the limitation is not explicit, the applicant has the burden of showing that a person of ordinary skill in the art "would have understood, at the time the patent application was filed, that the description requires the limitation." Hyatt, 47USPQ 2d @1131. An arbitrary narrowing of the scope of the claim is not compliant unless the description explicitly supports or would require the narrowing limitation.

Claim 17 recites **payment process means for performing a payment**. This claim element is a means plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. This allows the claim to refer to structure, material or acts in the

specification, as long as the function cited is clearly linked to a particular structure, material or act or a person of ordinary skill in the art would have understood what structure, material or acts perform the function. A general purpose computer is a particular structure for this purpose only if it is programmed with a particular algorithm, and clearly linked to the function claimed. See the algorithm requirement in *Aristocrat Technologies v. International Game Technology*, 86 USPQ2d 1235 (Fed. Cir. 2008) "the patent does not disclose the required algorithm or algorithms, and a person of ordinary skill in the art would not recognize the patent as disclosing any algorithm at all. See also MPEP 2181 and 2164.06(c) and the memo at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_6th_09_02_2008.pdf

When the written description fails to disclose the corresponding structure, material, or acts for the claimed function, then the scope of the claim covers any known or unknown structure, material or acts that would perform the recited function. In that case, the specification can only be enabling for the means known to the inventor, and other means are not enabled.

In this case, no particular physical structure, such as a general computer with a specific algorithm for accomplishing the recited function, is found for the following means. The lack of a clear link is addressed below under 35 USC 112 first, but they are also rejected as not being enabled for every possible known and unknown means of accomplishing the functions.

Claim 17 recites payment process means for performing a payment. The specification describes figuring out how much to charge, and notifying a user of the charges, and a mobile phone number to be charged, but this is arranging a payment; until funds are transferred, no payment is performed. The examiner does not find any algorithm for funds transfer that would correlate to performing a payment.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3, 6-11, 14, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites payment process means for performing a payment. Claim 17 appears to invoke 35 USC 112 sixth paragraph. This claim is not clearly linked to structure or acts in the specification, including an algorithm for performing the function claimed. A computer implemented means plus function limitation that invokes 35 USC 112 sixth paragraph is required to have more than just a general purpose computer as corresponding structure. The specification must also include the algorithm that transforms the computer into a special purpose computer, even if one of ordinary skill in the art could write it. The requirement that a particular structure be clearly linked with the claimed function in order to qualify as corresponding structure is the quid pro quo for the convenience of using 112 sixth, and is supported by 35 USC 112 second. See *Aristocrat*, 521 F.3d at 1334-8, 86 USPQ2d at 1240-1243, and also MPEP 2181.

Claims 1, 2, 6, 8, 9, 14, 15, and 17 recite the system having the retrieved address information. The antecedent is confusing because a first system retrieves the address of a second system. So the first system has the address in the sense that it has a copy of the address information, and the second system has the address in the sense that it is located at the address. If they both have the retrieved address, then the antecedent is unclear. The metes and bounds of the claim are unclear.

Claims 1, 2, 6, 8, 9, 14, 15 and 17 are not clear as to the systems involved. The claims introduce a first system whose address is stored in the storage unit. Then the retrieving step recites the system corresponding to the identification information received from the user device, from the storage unit. How is the user device from the storage unit? This is interpreted as the same first system. In the obtaining step, the claim further recites the system with the address information retrieved by the retrieving process unit. This system can be construed as the first system, addressed at the retrieved address, or it can refer to the server that now has the retrieved address information, and thus is a system with the information, and a system having the information. The antecedent is unclear. The system with/having the address information could refer to different parts of the server or the system of billing itself.

Claims 1, 2, 6, 8, 9, 14, 15 and 17 recite a system of billing a user. The claims further recite limitations based on the system having particular information: addresses. When the system is a conventional parking meter, the boundaries of the meter are pretty clear, and it can be determined what information is in that system. When the system is a non-specific network device, it is no longer clear where the boundaries of

the system are. It then becomes impossible to tell what information is in the system. For instance, is the local DNS server part of the system of billing a user? The metes and bounds of the claims are unclear, thus the claims are rejected.

Claim 6 recites a system use support method for a computer comprising a storage unit, the computer performing several steps. By this preamble, the steps performed by the computer are not required to be in the method claimed. What does system use support mean? What steps are in the system use support method?

Dependent claims 3, 7, 10 and 11 fail to remedy these problems and are also rejected.

While it is difficult to interpret the metes and bounds of the claims, especially for the reasons explained in the rejections under § 112, 2nd paragraph, the Examiner herein applies an art rejection based on her best interpretation of the claims in the interest of advancing prosecution.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 6-11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by US 20020032601 filed 4/25/01 by Admasu et al.

As to claims 8, 9, and 15, Admasu discloses in paragraph 15 page 2 a computer readable storage medium storing a program.

Claims 8, 9, and 15 are directed to a computer readable storage medium storing a program used to direct a computer to perform particular steps. In this construction, the particular steps are not necessarily on the medium, thus they are not part of the structure of the article of manufacture claimed. The steps are expressed as an intent, not as part of the physical structure of the medium. For example a first program that executes whatever program is on the d drive can be used to execute the claimed steps, without embodying the steps in the first program. Thus, the particular steps in this construction are non-functional descriptive matter, and do not serve to patentably distinguish the invention from any computer readable storage medium storing a program. The dependent claims 10 and 11 further modify the steps, and thus are also non-functional descriptive material.

The steps are only found in the non-functional descriptive material, and do not alter the recited structural elements; therefore this difference does not effectively serve to patentably distinguish the claimed invention over the prior art. The structural elements remain the same regardless of the specific intent. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate. See in Re Gulack, 703

F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F. 3rd 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004), and MPEP 2106.

Claim 6 recites a system use support method for a computer comprising a storage unit. Admasu discloses a system use support method (in claim 21) for a computer comprising a storage unit (paragraph 25 page 2.) The scope claimed is a system use support method. The method is intended for a computer, but the intent does not patentably distinguish the claim from the prior art. Consider a computer fan that cools the CPU. This is a system use support method for a computer comprising a storage unit, where the computer could perform any manner of other things. The steps recited in the claim are not recited as part of the method claimed, and thus are non-functional descriptive material and do not serve to patentably distinguish the claimed invention from the prior art.

Claim 7 further modifies the non-functional descriptive material, and thus does not patentably distinguish the claimed invention from the prior art.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 20020032601 filed 4/25/01 by Admasu et al, in view of US Patent 5974453 filed 10/8/97 by Andersen et al. in view of US 20030050793 filed with foreign priority to 3/27/2000 by Lejeune.

As to claim 1, Admasu teaches in paragraphs 14 and 15 page 2 a server and a processing device. Admasu teaches in claim 7 and paragraph 29 page 3 a storage unit storing identification information and address information of a system of billing a user for an amount. Admasu teaches in paragraph 15 page 2 billing a user for an amount based on a predetermined total length of time.

Admasu teaches in paragraphs 14 and 15, page 2, performing a communicating process through a network with a user device and the system. Admasu does not use the terms charge information nor use information, but clearly discloses sending information that would be in these categories.

As to charge and use information, Admasu teaches in paragraph 35 page 3 and paragraph 38 on pages 3 and 4 obtaining information requested by the user from the system. In the case of parking, the examiner does not find a patentably distinguishable difference between use information, charge information, and the information cited by Admasu: Amount of payment, time units purchased, time of expiration, and a list of occupied spaces. It would have been obvious to a person of ordinary skill in the art to recombine these elements and present them as charge information or use information; the difference is a minor issue of format; they are obvious variants. Thus it would have been obvious for a person of ordinary skill in the art at the time of the invention to

modify Admasu to explicitly state obtaining charge information or use information requested by the user from the system retrieved by the retrieving process unit. Let this argument be hereafter called "charge/use."

Admasu teaches retrieving the address information of the system corresponding to identification received from the user device, from the storage unit in paragraph 29 page 3. Admasu does not explicitly teach retrieving network address information.

Andersen teaches in col 2 lines 25-50 retrieving network address information. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add retrieving the system corresponding to identifying information received from the user device from a storage unit according to a request in order to take advantage of standardized readily available and proven reliable technology of DNS (domain name service) technology and tools. Let this argument be hereafter called "DNS."

Admasu teaches in paragraph 35 page 3 obtaining billing charge information requested by the user from the system with the address information retrieved by the retrieving process unit.

Admasu teaches in paragraph 35 page 3 transmitting the billing charge information to the user device.

Admasu teaches in paragraph 39 page 4 performing a payment according to a request for payment from the user device.

The Admasu Andersen combination does not teach transmitting a lock release request for releasing a lock of the system with the retrieved address information to the

system. Lejeune teaches in paragraph 55 page 3 transmitting a lock release request for releasing a lock of the system with the retrieved address information to the system (a signal to the transponder to open the exit barrier). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add transmitting a lock release request for releasing a lock of the system with the retrieved address information to the system in order to allow people to retrieve their vehicles upon payment.

13. Claims 2, 3, 6-11, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admasu et al, in view of Andersen et al. in view of LeJeune as applied above, and further in view of US Patent Application 2002/0147673 filed 1/31/01 by Allen.

As to claims 2, 6, 8, 9, 14, 15 and 17, Admasu teaches in paragraphs 14 and 15 page 2 a server and a processing device. Admasu teaches in claim 7 and paragraph 29 page 3 a storage unit storing identification information and address information of a system of billing a user for an amount. Admasu teaches in paragraph 15 page 2 billing a user for an amount based on a predetermined total length of time.

As to claims 2, 8, 9, 14, 15 and 17, Admasu teaches in paragraphs 14 and 15 page 2 performing a communicating process through a network with a user device and the system.

As to claims 2, 6, 8, 9, 14, and 17, Admasu in view of Andersen teaches retrieving the address information of the system corresponding to identification received from the user device, from the storage unit as above under DNS.

As to claims 2, 6, 8, 9, 14, 15, and 17, Admasu teaches obtaining current use information relating to a use of the system with the address information retrieved by the retrieving processing unit as above under charge/use.

As to claims 2, 6, 8, 9, 14, 15 and 17, Admasu teaches a registration phase in which notification information such as contact information (paragraph 26 page 2) is received into the system. Admasu does not teach receiving notification timing information relating to a timing of notifying the user device of the current use information. Allen teaches in paragraph 25 page 3 request for timing preferences for notifications through user devices. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add receiving notification timing information relating to a timing of notifying the user device of the current use information in order to allow the user to set contact preferences and avoid annoying the user with undesired contacts.

As to claims 2, 6, 8, 9, 15 and 17, Admasu teaches in paragraph 35 page 3 transmitting the obtained use information to the user device according to the notification timing information received from the user device.

As to claims 2, 6, 8, 9, 14, 15, and 17, Admasu does not teach transmitting a lock release request for releasing a lock of the system with the retrieved address information to the system. Lejeune teaches in col 4 line 66 to col 5 line 15 transmitting a lock

release request for releasing a lock of the system with the retrieved address information to the system. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add transmitting a lock release request for releasing a lock of the system with the retrieved address information to the system in order to allow people to retrieve their vehicles upon payment.

As to claims 14 and 15, Admasu teaches in paragraph 39 page 4 performing a payment according to a request for payment from the user device.

As to claims 8, and 17, Admasu teaches in paragraph 39 page 4 performing a payment by communicating with the system of billing a user for up to a predetermined total time. Admasu teaches obtaining charge information from the system through the network as above under "charge/use."

As to claim 6, Admasu teaches in paragraph 42 page 4 receiving identification information of a system of billing a user for an amount, the amount based on a predetermined total length of time, and user information from a user device.

As to claim 15, Admasu teaches obtaining use information about a user who uses a system of billing a user for an amount, the amount based on a predetermined total length of time as above under "charge/use". Admasu does not disclose, but Allen paragraph 25 page 3 discloses as above, determining a transmission timing of a message according to the obtained use information, and transmitting the message to the user device through the network with the transmission timing. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add determining a transmission timing of a message according to the

obtained use information, and transmitting the message to the user device through the network with the transmission timing in order to make the contacts as useful to the user as possible.

As to claim 3 (dependent on 2), Admasu teaches in paragraph 27 pages 2 and 3 the payment is made in a pre-payment system for a predetermined time. Admasu teaches in paragraph 46 page 4 a message is transmitted to the user device at any time before the predetermined time elapses.

As to claims 7, 10 and 11, Admasu teaches in the abstract the system of billing a user by a predetermined time is a parking meter, and the charge is a parking charge for use of the parking meter.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

/Susanna M. Diaz/

Primary Examiner, Art Unit 3692